

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

Status of Claims

Claims 1, 2 and 5-19 are pending in this application. Claims 1, 10 and 16-19 are independent. All of the pending claims stand rejected. By this amendment, claims 1, 10 and 16-19 are amended. No new matter has been amended by this amendment.

Claim Rejections – 35 U.S.C. § 112

In paragraph six (6) of the Final Office Action, claims 1, 10, 16, 17, 18 and 19 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply the written description requirement. The Office Action indicates that “the specification does not disclose of ‘receiving a request from the client’ for the purpose of registration of electronic mail account and format.”

First of all, Applicants believe that the term “registration” for a service inherently requires certain interactions with a client including receiving a request from the client.

Secondly, Applicants believe that the original specification inherently teaches the meaning of registration to include a step of receiving a request from the client. For example, Fig. 3 discloses an example of a table for storing destination information (e.g., a client) such as the name of user and the email address. A portion of the original specification describes that “an area in Fig. 3 mentioned later is newly provided, which stores for each client detailed settings such as an electronic mail address...” (i.e., page 5, lines 20-22). Another portion of the original specification teaches how this table is configured to be set from the operation unit 5 as shown in Fig. 1. For example, the relevant portion of the specification describes that “a LAN distribution

key is allocated for table registration, and when this key is pressed, operations such as adding a client to this table, changing the settings and deleting a client can be performed. In Fig. 3, the information to be stored includes client and user abbreviations for the sake of identifying distribution registrations,...” (i.e., page 9, lines 8-15)

In view of the foregoing description, Applicants believe that an ordinary skill in the art would have understood the meaning of “registration” as used in the specification and that the registration would require a step of receiving a request from the client.

Reconsideration and withdrawal of the rejections of claims 1, 10, 16, 17, 18 and 19 under 35 U.S.C. §112, first paragraph, is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

In paragraph eight (8) of the Final Office Action, claims 1, 2, 7, 8, 10, 13, 16, 17, 18 and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,157,706 to Rachelson (“Rachelson”) in view of U.S. Patent Application Publication No. 2002/0075524 to Blair et al. (“Blair”). In paragraph ten (10) of the Final Office Action, claims 5, 12, 14 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rachelson in view of Blair, and in further view of U.S. Patent No. 6,658,456 to Shimoosawa (“Shimoosawa”). In paragraph eleven (11) of the Final Office Action, claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Rachelson in view of Blair, and in further view of U.S. Patent No. 6,721,783 to Blossman et al. (“Blossman”). In paragraph twelve (12) of the Final Office Action, claims 9 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rachelson in view of Blair, and in further view of U.S. Patent No. 6,883,016 to Fuji et al. (“Fuji”).

Rachelson discloses a method/apparatus that allegedly enables a fax machine to behave like an email client thereby enabling a user having only a fax machine to send/receive an email to/from another user. For example, Rachelson's apparatus is configured in such a way that the facsimile print out received by a user who has only a fax machine (i.e., who does not have a computer as well connected to, e.g., the Internet) contains the contents of an e-mail message intended for the user. If the user wants to send an email from his fax machine to a recipient who has an email address, the user dials an internet fax number associated with the email address of the recipient using an "address book" of email addresses. The Rachelson's apparatus then converts the fax message from the user into an email message containing the contents of the fax message, and sends the email to the recipient associated with the internet fax number. See, e.g., abstract and col. 2, lines 11-42 of Rachelson.

Independent claims 1, 10 and 16-19 have been amended for further clarification. In particular, amended claim 1 recites, *inter alia*, "reception means for receiving facsimile data, which includes color image information and/or monochrome image information, ..." and "generating means for generating an electronic mail ... where the electronic mail has an attachment generated based on the color image information and/or monochrome image information received by said reception means." Other amended independent claims 10 and 16-19 have similar features to amended claim 1 as described herein. Support for the amendment may be found, for example, at Fig. 6 and relevant portion of the specification (e.g., page 11, line 8 through page 13, line 13).

One of the aspects of the present invention as featured in the amended claims generates an email having an attachment generated based on the image information included in the received facsimile data.

Applicants believe that Rachelson fails to show or suggest this aspect of the present invention as specifically recited in the amended claims as discussed above, i.e., generates an email having an attachment generated based on the image information included in the received facsimile data. It appears that Rachelson's apparatus simply converts the received email to a graphic file for faxing, or converts the received fax message into a graphics file before sending it as email. For example, portions of Rachelson describes:

The described embodiment of the present invention converts received e-mail to a TIF file for faxing. Other implementations of the present invention may convert e-mail to GIF format, or any other appropriate format. This implementation offers GIF and PostScript as well. (col. 10, lines 60-64)

The described embodiment of the present invention converts received fax messages to a graphics file before sending it as e-mail. In step 1216, the outgoing e-mail is converted to a graphical format preferred by the recipient (as indicated by the recipient database). If the recipient has not indicated a preference (via an email command system, not shown), the facsimile message is converted to TIF format. Other possibilities that the recipient can indicate include GIF, UU Encode, Mime, and PostScript. (col. 11, lines 21-29)

Blair is cited as merely disclosing "receiving color image information." (page 5 of the Final Office Action) Shimoosawa is cited as disclosing a communication apparatus wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail. (page 8 of the Final Office Action). Blossman is cited as disclosing method of sending bank customers images of bank related documents through email. (page 10 of the Final Office Action). Fuji is cited as disclosing procedure based on the ITU-T T. 37.

Applicants, however, believe that none of the cited references shows or suggests the inventive aspect of the present application as discussed above, i.e., generates an email having an attachment generated based on the image information included in the received facsimile data.

Accordingly, each of independent claims 1, 10 and 16-19 as amended is neither anticipated by nor rendered obvious in view of the cited references (i.e., Rachelson, Blair, Shimoosawa, Blossman and Fuji), either taken alone or in combination, for at least the reasons discussed above.

Reconsideration and withdrawal of the rejections of claims 1, 10 and 16-19 under 35 U.S.C. §103(a) is respectfully requested.

Applicants have not independently addressed the rejections of the dependent claims. Applicants submit that, in view of the amendments to the claims presented herein and, for at least similar reasons as to why the independent claims from which the dependent claims depend are believed allowable as discussed supra, the dependent claims are also believed allowable. Applicants however, reserve the right to address any individual rejections of the dependent claims should such be necessary or appropriate.

Applicants believe that the application as amended is in condition for allowance and such action is respectfully requested.

AUTHORIZATION

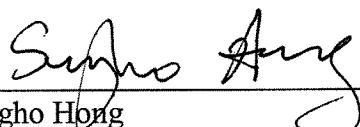
A petition for a one-month extension of time along with the associated fee is enclosed, extending the date for responding until March 29, 2007. Should an additional extension of time be required to render this paper timely filed, such extension is hereby petitioned and the Commissioner is authorized to charge any other fees necessitated by this Amendment, or credit any overpayment to our Deposit Account No. 13-4500 (Order No. 1232-4792). A DUPLICATE COPY OF THIS SHEET IS ENCLOSED.

An early and favorable examination on the merits is respectfully requested.

Respectfully submitted,
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Dated: March 28, 2007

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